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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,047	12/15/2003	Jacob A. Flagle	8627/44	4057
7590 11/15/2005				
J. Matthew Buchanan Brinks Hofer Gilson & Lione P.O. Box 10395 Chicago, IL 60610		EXAMINER FOREMAN, JONATHAN M		
		ART UNIT 3736 PAPER NUMBER		

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/736,047

Applicant(s)

FLAGLE ET AL.

Examiner

Jonathan ML Foreman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/20/04</u> . | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Information Disclosure Statement*

The information disclosure statement filed 2/20/04 complies with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. It has been placed in the application file, and the information referred to therein has been considered by the examiner as to the merits.

### *Claim Objections*

1. Claim 16 is objected to because of the following informalities: In regards to claim 16, line 2 states "the distal end". However, "the distal end" lacks antecedent basis in the claim. Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 26 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,040,543 to Badera et al.

In regards to claims 26 and 28, Badera et al. discloses a guidewire having an elongate member (4) including a proximal and distal end (8); and a coating (6) disposed on the distal end (8) of the elongate member (Figure 2), the coating comprising a flexible tip extending beyond the distal

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end (Col. 4, lines 41 – 44) and a solid member (12) spaced from the distal end wherein a portion of the coating is disposed between the distal end and the solid member (Figure 1).

4. Claims 1 and 6 – 13 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,385,152 to Abele et al.

In regards to claims 1 and 6 – 13, Abele et al. discloses an elongate member (Figure 11a) having a proximal end (402), a main body having a first diameter (Col. 9, lines 39 – 40), a distal end having a second diameter (Col. 9, lines 41 – 43), and a taper portion (417) disposed between the main body and a distal end and defining a taper between the first and second diameters; and a coating disposed on the distal end and comprising a flexible tip having a length axially extending beyond the distal end (Col. 9, lines 48 – 50), the ratio of the length to the first diameter being greater than 3:1 and between 12:1 and 250:1. Abele et al. discloses the length of the flexible tip being greater than 3mm (Col. 9, line 49). The coating is disposed on the taper portion and a portion of the main body (Figure 11a). The elongate member is either stainless steel or nitinol (Col. 9, line 22). A lubricious coating is disposed on a portion of the main body (Col. 11, lines 17 – 21).

5. Claims 1 - 28 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Application No. 2003/0069521 to Reynolds et al.

In regards to claims 1 – 28, Reynolds et al. discloses an elongate member (Figure 7) having a proximal end, a main body (134) having a first diameter, a distal end (154) having a second diameter, and a taper portion (146) disposed between the main body and a distal end and defining a taper between the first and second diameters; and a coating (170) disposed on the distal end and comprising a flexible tip having a length axially extending beyond the distal end, the ratio of the length to the first diameter being greater than 3:1 and between 12:1 and 250:1 [0063]. Reynolds et al. discloses the length of the flexible tip being greater than 3mm [0063]. The length of the flexible

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tip extending beyond the distal tip is greater than the length of the distal tip [0063]. The coating is disposed on the taper portion and a portion of the main body (Figure 7). The elongate member is either stainless steel or nitinol [0034][0035]. A lubricious coating is disposed on a portion of the main body [0051][0062]. The flexible tip comprises radiopaque material [0061]. A solid marker is disposed in the flexible tip and a portion of the coating is disposed between the distal end of the elongate member and the marker in that the flexible tip is impregnated with radiopaque materials [0061].

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan ML Foreman whose telephone number is (571)272-4724. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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